

# Best Available Copy

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Refund Section - PATENT & TRADEMARK  
Accounting Division  
Office of Finance

In Re Application of: Osamu NAGAI et al

Serial No.: 10/030076

Filed: January 10, 2002

Title: GASKET FOR FUEL BATTERY AND  
METHOD OF FORMING THE SAME

## REQUEST FOR REFUND

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

In the above identified case, deposit account 06-1358 has been improperly debited.

By this paper, a credit to deposit account 06-1358 is requested. An explanation of the debiting error is set out below, and copies of all documents in support of this request are attached.

### Explanation of Error:

- Large Entity fee charged to Small Entity
- Fee should not have been charged to PTO account because it was paid by check
- PTO miscalculation
- Unknown and unidentifiable PTO charge

# Best Available Copy

Type of Charge and Amount of Refund Requested:

Extension of Time                                  \$ 1020.00

TOTAL REFUND REQUESTED                                  \$ 1020.00

Comments:

On July 27, 2004 a Petition was filed requesting a refund of three months Extension of Time payment of \$950. On May 27, 2005 a Decision on the Petition was received confirming a refund of \$950 was applicable. However, on October 14, 2005, a further \$1020 charge for three months Extension of Time was applied to undersigned counsel's deposit account 06-1358. Since the further fee of \$1020 is a PTO error, it is requested that a refund of \$1020 and \$950 totaling \$1970 be applied to undersigned counsel's deposit account 06-1358.

Attached Documents:

Deposit account statement (highlighted)

Copy Decision on Petition confirming refund was appropriate

Respectfully submitted

JACOBSON HOLMAN PLLC

By \_\_\_\_\_

  
John C. Holman  
Registration No. 22,769  
400 Seventh Street, N.W.  
Washington, D.C. 20004-2218  
(202) 638-6666

I.D.: JCH/dls  
Folio: P67506US0  
Date: January 23, 2006



# Best Available Copy

JCH

P67506 US

UNITED STATES PATENT AND TRADEMARK OFFICE

DIC 6/3/05  
TC 6-3-05



Mailed: 5/27/05.

In re application of

Nagai et al.

Serial No. 10/030,076

Filed: January 10, 2002

For: GASKET FOR FUEL BATTERY AND METHOD OR FORMING THE SAME

Commissioner for Patents  
United States Patent and Trademark Office  
P.O. Box 1450  
Alexandria, VA 22313-1450  
[www.uspto.gov](http://www.uspto.gov)

td

## DECISION ON PETITION

This is a decision on the PETITION UNDER 37 CFR 1.181 TO DIRECT THE EXAMINER ISSUE A NEW NON-FINAL OFFICE ACTION.

The instant application is a National Stage Application entry of PCT/JP00/03853 filed on January 10, 2002. On February 20, 2004, a non-final office action was mailed to Applicants. Applicants contacted the examiner on June 10, 2004 and pointed out that two claims were not addressed in the office action. Apparently, a preliminary amendment was lost or misplaced by the office and was never processed. On July 21, 2004, applicants again contacted the examiner. The examiner stated that no new office action would be sent out and that Applicants should respond to the outstanding office action. Applicants file a response to the outstanding office action on July 27, 2004. The instant petition was timely filed simultaneously with this response formally requesting that a new non-final office action be prepared and mailed. In response to the amendment, the examiner required a restriction requirement on August 12, 2004. In the office action, it was stated that any subsequent action would be made final because Applicants had already received a first action on the merits. In an interview on August 30, 2004, the examiner's supervisor told Applicant's representative that the restriction would rescinded in order for a decision to be made with regard to the instant petition.

The instant petition requests that a new non-final office action addressing all of the pending claims be prepared. It is also requested that applicants be given a refund of the extension of time fee paid on July 27, 2004.

## DECISION

The request for a new non-final office action to be mailed will be addressed first. Applicants have submitted a copy of the post card receipt from the office dated January 10, 2002. This receipt lists the various papers that were hand carried to the office. Among the papers listed is a preliminary amendment and an Article 19 amendment. Applicants faxed copies of the post card receipt and the amendments filed with the application to the examiner on June 10, 2004. It is clear from these documents that the original papers were either lost or misplaced by the office. It

# Best Available Copy

is unclear as to why the examiner would not immediately issue a new non-final office action due to error on the part of the office.

Next, the request for a refund of the extension of time fee will be addressed. As previously stated, the examiner should have issued a new non-final office action. Applicants should not have been made to file a response to the office action mailed February 20, 2004 because said action was based on an incomplete copy of the claims. The request for a refund of the fees is appropriate.

Lastly, while not specifically addressed in the petition, the restriction requirement made by the examiner on August 12, 2004 will be reviewed. Although the examiner's supervisor rescinded the requirement in an interview on August 30, 2004, it is noted that the restriction requirement was improper on its face. The examiner required a species election and an election between numerous groups under 35 USC 121. It is noted however, that the instant application was filed under 35 USC 371. National stage applications do not fall under 35 USC 121 but rather lack of unity practice should be followed.

Accordingly, the petition is **GRANTED**. The examiner is directed to prepare a new non-final office action addressing all of the pending claims on the merits. In addition, applicants are to be refunded the extension of time fee paid on July 27, 2004.

JM Stone

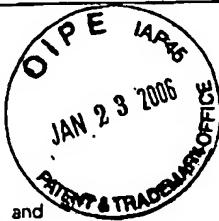
Jacqueline M. Stone, Director  
Technology Center 1700  
Chemical and Materials Engineering

JACOBSON HOLMAN PLLC  
400 SEVENTH STREET N.W.  
SUITE 600  
WASHINGTON DC 20004



# Best Available Copy

## UNITED STATES PATENT AND TRADEMARK OFFICE



Commissioner for Patents  
United States Patent and Trademark Office  
P.O. Box 1450  
Alexandria, VA 22313-1450  
[www.uspto.gov](http://www.uspto.gov)

### MONTHLY STATEMENT OF DEPOSIT ACCOUNT

To replenish your deposit account, detach and return top portion with your check. Make check payable to Director of Patents & Trademarks.

JACOBSON PRICE HOLMAN & STERN  
BRUCE LETCHWORTH  
400 SEVENTH STREET, N. W.  
WASHINGTON DC 20004

FINA

Account No.
061358
Date
10-31-05
Page

PLEASE SEND REMITTANCES TO:  
U. S. Patent and Trademark Office  
P.O. Box 70541  
Chicago, IL 60673

DATE POSTED MO. DAY YR.	CONTROL NO.	DESCRIPTION (Serial, Patent, TM, Order)	DOCKET NO.	FEE CODE	CHARGES/ CREDITS	BALANCE
10 4 05	5	2947057		6214	100.00	13034.74
10 4 05	105	60483010		8007	20.00	13014.74
10 5 05	5	2947057		6214	-100.00	13114.74
10 5 05	6	2947057		6214	100.00	13014.74
10 6 05	1	2947057		6214	-100.00	13114.74
10 6 05	2	2947057		6212	100.00	13014.74
10 6 05	15	10532349	P705323US0	1642	400.00	12614.74
10 11 05	207	60699366	LHS	8007	20.00	12594.74
10 12 05	1	10415665		2202	25.00	12569.74
10 12 05	6	10695441	P67936US0	1201	200.00	12369.74
10 12 05	80	2956723		8503	15.00	12354.74
10 13 05	40	10505885		8021	40.00	12314.74
10 13 05	349	10967305		8007	120.00	12194.74
10 14 05	1	10030076	P67506US0	1253	1020.00	11174.74
10 14 05	158	60615594		8007	20.00	11154.74
10 14 05	159	60615595		8007	20.00	11134.74
10 14 05	269	60625115	11472/P70233US0	8007	20.00	11114.74
10 19 05	7	10398513	P68756US0	2201	200.00	10914.74
10 21 05	213	10498516	P69853US0	8021	40.00	10874.74
10 24 05	6	10509950	P67772US1	1617	-130.00	11004.74
10 27 05	146	78695796	MGG	8513	50.00	10954.74
10 27 05	261	29234544	P70621US0	1806	180.00	10774.74
10 28 05	1	76477928	T33819	6004	300.00	10474.74
10 28 05	5	10110140	P68450US0	1252	330.00	10144.74
AN AMOUNT SUFFICIENT TO COVER ALL SERVICES REQUESTED MUST ALWAYS BE ON DEPOSIT				OPENING BALANCE	TOTAL CHARGES	TOTAL CREDITS
				13134.74	3320.00	330.00
						CLOSING BALANCE
						10144.74

United States Patent and Trademark Office  
- Sales Receipt -

10/14/2005 RWIMBUSH 00000001 061358 10030076

01 FC:1253 1020.00 DA

Best Available Copy

Adjustment date: 03/29/2006 EEKUBAYI  
10/14/2005 RWIMBUSH 00000001 061358 10030076  
01 FC:1253 1020.00 CR